OIPE
SEP 23 2004
TRADEMARK OFFICE
JC998

GREENBLUM & BERNSTEIN, P.L.C.
Intellectual Property Causes
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Attorney Docket No. P20825

In re application of : Y. AIDA et al.

Application No. : 09/787,437

Filed : March 27, 2001

For : APOPTOSIS INDUCING AGENT

Mail Stop Amendment
Group Art Unit: 1646

Examiner: J. Stucker

Mail Stop Amendment
Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202
Sir:

Transmitted herewith is an **Election with traverse** in the above-captioned application.

____ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.

____ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.

____ A Request for Extension of Time.

__X__ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 21	*21	0	x 9=	$	x 18=	$0.00
Indep. Claims: 2	**3	0	x 43=	$	x 86=	$0.00
Multiple Dependent Claims Presented			+145=	$	+290=	$0.00
Extension Fees for ____ Month(s)				$		$0.00
			Total:	$	Total:	$0.00

* If less than 20, write 20
** If less than 3, write 3

____ Please charge my Deposit Account No. 19-0089 in the amount of $_____.

N/A A check in the amount of $_____ to cover the *filing/extension* fee is included.

__X__ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

__X__ Any additional filing fees required under 37 C.F.R. 1.16.

__X__ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

Bruce H. Bernstein
Reg. No. 29,027

33,094

OIPE
SEP 23 2004
JC98
PATENT & TRADEMARK OFFICE

P20825.A16

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Yoko AIDA et al.

Group Art Unit: 1646

Serial No : 09/787,437
(National Stage of PCT/JP99/00388)

Examiner: J. Stucker

Filed : March 27, 2001
(International Filing Date January 29, 1999)

For : APOPTOSIS INDUCING AGENT

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop_____
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This paper is responsive to the Requirement for Restriction mailed from the Patent and Trademark Office August 24, 2004, in the above application. Inasmuch as the one-month shortened statutory period is set in the Office Action to expire on September 24, 2004, Applicants submit that this Election is timely filed. However, if any extension of time is deemed to be necessary, the same is hereby requested and the Patent and Trademark Office is authorized to charge any extension of time fees and any other fees necessary for maintaining the pendency of this application to Deposit Account No. 19-0089.

Reconsideration and withdrawal of the requirement for restriction are respectfully requested in view of the remarks which follow:

RESTRICTION REQUIREMENT

The Restriction Requirement states that the Examiner has determined that 6 distinct inventions are contained in this application, namely:

I Claims 1-3, 8, 9 and 16-19, drawn to a protein, classified in Class 530, subclass 350;

II Claims 4, 6, 10, 11, 14 and 15, drawn to a gene encoding a protein and a vector, classified in Class 536, subclass 23.72;

III Claim 5, drawing to a method for inducing apoptosis using a protein, classified in Class 435, subclass 91.33;

IV Claim 7, drawn to a method for inducing apoptosis using a vector, classified in Class 435, subclass 320.1;

V Claims 12, 20 and 21, drawn to a method for preventing or treating cancer of AIDS with a protein, classified in Class 530, subclass 300; or,

VI Claim 13, drawn to a method for preventing or treating cancer of AIDS with a vector, classified in Class 435, subclass 320.1.

The Requirement has therefore required that an election be made between these inventions. The Restriction Requirement also requires an election between the species of cancer or AIDS.

ELECTION

In response to the Restriction Requirement, Applicants elect the invention of Group II (claims 4, 6, 10, 11, 14 and 15), with traverse. Further, Applicants elect the species AIDS. Applicants respectfully submit that at least claims 1-21 are generic, and at least claims 1-21 are readable on the elected species.

TRAVERSE

Notwithstanding the election of the claims of Group II in order to be responsive to the requirement for restriction, Applicant respectfully traverses the requirement.

The Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. § 1.475 must be considered. Specifically, § 1.475(a) sets forth the definition of the requirement for unity of invention, and the unity of invention that must be satisfied, where a group of inventions is claimed, in order to have the right to include multiple inventions in a single application. In particular, § 1.475(a) states that a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept. In this regard, it is stated that:

> Where a group of inventions is claimed in an application, the requirement for unity of invention shall be fulfilled only when there is technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole makes over the prior art.

Further, § 1.475(b) defines several combinations of different categories of claims which always fulfill the unity of invention requirements of § 1.475(a) where the same or corresponding special technical features is claimed. Thus, the requirement for unity of invention is fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. In the instant situation, the claimed protein can be considered to be analogous to claims directed to the protein of Group I , the methods for inducing apoptosis using a protein of Groups III and IV, and the methods for preventing or treating cancer or AIDS of Groups V and VI.

Thus, the presently pending claims have unity of invention, whereby the instant restriction requirement is improper, and should be withdrawn.

Still further, the requirement asserts that the inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The requirement asserts that the claims lack a corresponding special technical feature because the common technical feature is truncated HIV Vpr protein is known and is, therefore, not a contribution over the art (see Piller et al., Lavallee et al., Yuan et al., and Dedera et al.). However, the requirement does not indicate how the claims are considered anticipated or obvious over Piller et al., Lavallee et al., Yuan et al., and Dedera et al. The Restriction Requirement fails to bear the burden of proving unpatentability under U.S. Patent law. The Restriction Requirement fails to bear the burden of proving unpatentability, and accordingly, the assertions contained therein are without appropriate basis, and the restriction should be withdrawn.

In view of the foregoing, it is respectfully requested that the Examiner seriously reconsider the requirement for restriction, and withdraw the same s4 as to give an examination on the merits on all of the claims pending in this application. In any event, the claims should be rejoined upon allowance of the elected claims.

CONCLUSION

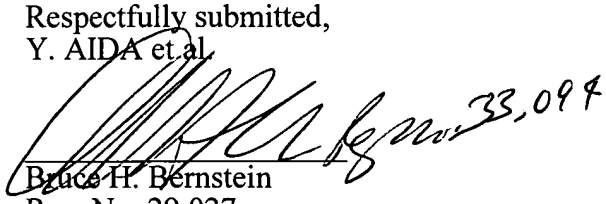
For the reasons discussed above, it is respectfully submitted that the requirement for restriction is improper because unity of invention is present, and the requirement should be withdrawn.

Withdrawal of the requirement restriction with examination of all pending claims is respectfully requested.

Favorable consideration with early allowance of the application is most earnestly requested.

Should the Examiner have any questions, please contact the undersigned at the telephone number provided below.

Respectfully submitted,
Y. AIDA et al.



Bruce H. Bernstein
Reg. No. 29,027

September 22, 2004
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191